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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,010

04/18/2007

Myriam Bouet-Griffon

2901683-000026

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59554

7590

11/20/2009

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EXAMINER

LEE, REBECCA Y

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

11/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,010	Applicant(s) BOUET-GRIFFON ET AL.	
	Examiner REBECCA LEE	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 2 and 6 are cancelled. Claims 1, 3-5 and 7-20 are pending where claims 1, 11 and 14 are amended in view of amendment filed 11/13/09, where claim 1 is amended by incorporating cancelled claims 2 and 6 into claim 1.

Status of Previous Rejections

The rejection of claims 1 and 5-11 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of amendment filed 11/13/09.

The rejections of claims 1, 3-5 and 7-20 under 35 U.S.C. 103(a) have been maintained (with cancelled claims 2 and 6 incorporated into claim 1).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-5 and 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evancho et al. (US4082578).

Evancho et al. is applied to claims 1, 3-5 and 7-20 as set forth in the 08/14/09 office action (with cancelled claims 2 and 6 incorporated into claim 1).

With respect to the amended feature of “has been treated by solution, quenching and age hardening at room temperature” in claim 1, such limitation is considered as process limitations in a product by product claim. It is well settled that a product-by-

Art Unit: 1793

process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, the burden falls upon the applicant to show that any process steps associated therewith results in a product materially different from that disclosed in the prior art. See *In re Thorpe*, (227 USPQ 964), *In re Brown*, (173 USPQ 685), *In re Fessman*, (180 USPQ 524) and MPEP 2113. In the instant case, the aluminum alloy appears to be substantially identical with claimed, burden is on applicant to show the recited process is in fact results in a materially different product compared to the alloy of Evancho et al.

Response to Arguments

Applicant's arguments filed 11/13/09 have been fully considered but they are not persuasive.

Applicant first argues the claimed product solves the problem of that there is a difference in the expansion that occurs between aluminum skin parts and steel frames during electrophoresis treatment, while the aluminum alloy of Evancho et al. does not. However, this argument is incommensurate with the scope of instant claims since instant claims do not require such a feature. In addition, since Evancho et al. disclose a substantially similar aluminum alloy as claimed, one of ordinary skill in the art would have expected the aluminum alloy of Evancho et al. to show similar properties as instant invention.

Applicant also argues Evancho et al. do not teach the aluminum alloy can be a body roof as claimed in the disclosed examples. However, as stated in the previous

Art Unit: 1793

action, Evancho et al. disclose the aluminum alloy can be used as motor vehicle body skin, which does not exclude any portion of the motor vehicle body and does not limit to the hood disclosed in one example. Therefore, applicant's argument is not convincing.

Applicant also argues during different stages of making the aluminum alloy, Evancho et al. do not show the same process of making the aluminum alloy or different yield strength in certain stage. However, as stated in the previous action, the aluminum alloy of Evancho et al. exhibits a yield strength of 159-207 MPa, which overlaps the claimed range, and is prima facie evidence of obviousness MPEP2144.05 I. In addition, the recited process steps are considered as process limitations in a product by process claims. It is well settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, the burden falls upon the applicant to show that any process steps associated therewith results in a product materially different from that disclosed in the prior art. See *In re Thorpe*, (227 USPQ 964), *In re Brown*, (173 USPQ 685), *In re Fessman*, (180 USPQ 524) and MPEP 2113. In the instant case, the aluminum alloy appears to be substantially identical with claimed, burden is on applicant to show the recited process is in fact results in a materially different product compared to the alloy of Evancho et al.

Applicant also argues Evancho et al. disclose a different copper content from claimed. However, as stated in the previous action, the amount of copper present in the aluminum alloy is a result effective variable since Evancho et al. teach the addition of copper can increase the strength level of the final product (Column 7, lines 22-44).

Therefore, it would have been obvious to one of ordinary skill in the art to have

Art Unit: 1793

optimized the amount of Cu present in the aluminum alloy of Evancho et al. in order to achieve a desired product MPEP 2144.05 II.

Applicant then tries to show unexpected results obtained by the instant invention. The examiner would like to remind the applicant that any objective evidence such as unexpected result must be factually supported by an appropriate affidavit or declaration to be of probative value. See *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) and MPEP 716.01(c). Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP § 716.02(d) - § 716.02(e). Since the proof of factual evidence is lacking in applicant's assertion of unexpected results, the examiner does not find the argument persuasive.

Therefore, applicant's arguments are not persuasive.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 1793

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REBECCA LEE whose telephone number is (571)270-5856. The examiner can normally be reached on Monday-Friday 8:00 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROY KING can be reached on (571)272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./

/Roy King/

Application/Control Number: 10/561,010

Page 7

Art Unit: 1793

Examiner, Art Unit 1793

Supervisory Patent Examiner, Art
Unit 1793